

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 133087.12501(101420-1PUS)									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10/599,377	Filed September 27, 2006									
	First Named Inventor Ulf Larsson										
	Art Unit 1624	Examiner Venkataraman Balasubramanian									
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top;">/Paul K. Legaard, Reg.#38534/ _____ Signature</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top;">Paul K. Legaard _____ Typed or printed name</td></tr><tr><td style="vertical-align: top;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38534</u></td><td style="vertical-align: top;">610.640.7859 _____ Telephone number</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top;">3 September 2008 _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	/Paul K. Legaard, Reg.#38534/ _____ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Paul K. Legaard _____ Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38534</u>	610.640.7859 _____ Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	3 September 2008 _____ Date
<input type="checkbox"/> applicant/inventor.	/Paul K. Legaard, Reg.#38534/ _____ Signature										
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Paul K. Legaard _____ Typed or printed name										
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38534</u>	610.640.7859 _____ Telephone number										
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	3 September 2008 _____ Date										
<input checked="" type="checkbox"/> *Total of <u>one</u> forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

DOCKET NO.: 133087.12501 (101420-1P US)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: **Larsson and Radevik**

Serial No.: **10/599,377**

Group Art Unit: **1624**

Filed: **September 27, 2006**

Examiner: **Venkataraman Balasubramanian**

Confirmation No.: **7759**

Title: **Chemical Process**

Filed via EFS-Web

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Pre-Appeal Brief Request for Review

In response to the Final Rejection dated April 23, 2008 and the Advisory Action dated August 5, 2008, Applicants respectfully request reconsideration of the pending rejections.

I. Claims 1, 3-12, 16, 17, and 19 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by International Application Publication WO 01/92263 (hereinafter, the “Larsson reference”).

The Office has clearly erred by not establishing that the Larsson reference teaches every element recited in the pending claims.

For example, the Larsson reference **does not** teach conducting a one-pot hydrogenation of a compound of formula (III) “**firstly at about 20°C to form a compound of formula (IV)...**” as recited in claim 1 (emphasis added). Applicants submit that the Office **must** point out in the Larsson reference where this step is taught to maintain the rejection. In the absence of teaching each feature of the claimed invention, the Larsson reference does not anticipate

Applicants' claimed invention. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

II. Claims 1, 3-5, 9, and 11 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by European Patent Application No. 0508687A1 (hereinafter, the "Fisons reference").

The Office has clearly erred by not establishing that the Fisons reference teaches every element recited in the pending claims.

For example, the Fisons reference **does not** teach "hydrogenating a compound of formula (II) with a suitable transition metal **catalyst**..." as recited in claim 1 (emphasis added). The Office asserts that the reduced iron powder in step iv) of Example 9 in the Fisons reference is a suitable transition metal catalyst. The reduced iron powder, however, operates in a stoichiometric manner and is consumed in this chemical process. As one skilled in the art understands, a catalyst operates in a non-stoichiometric manner and is not consumed in the chemical process. Further, Applicants' specification distinguishes between a "transition metal" and a "transition metal catalyst" at page 3, lines 4-6 (which is recited below for convenience):

Suitable transition metal catalyst for the hydrogenation of a compound of formula (II) is, for example, platinum or palladium, or a combination of platinum with another transition metal such as vanadium, iron or manganese.

Thus, the reduced iron powder of the Fisons reference is a transition metal and **not** a catalyst, let alone "a suitable transition metal catalyst." In the absence of teaching each feature of the claimed invention, the Fisons reference does not anticipate Applicants' claimed invention. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

III. Claims 1 and 3-20 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Larsson reference in view of U.S. Patent No. 6,818,720 (hereinafter, the "Krauter reference").

The Office has clearly erred by not establishing that the combination of the Larsson and Krauter references teaches every element recited in the pending claims.

For example, the Krauter reference does not cure the deficiency of the Larsson reference referred to above. That is, the Krauter reference does not teach or suggest conducting a one-pot hydrogenation of a compound of formula (III) **“firstly at about 20°C to form a compound of formula (IV)...”** as recited in claim 1 (emphasis added). In contrast, the Krauter reference reports hydrogenation of “aromatic nitro-compounds” or “nitroaromatics” and, in particular, “nitrobenzene to aniline” and “dinitrotoluenes to toluenediamines” with particular “supported hydrogenating catalysts in powder form, which contains, as catalytically active components, a mixture of a primary precious metal component, a secondary precious metal component and one or more non-precious metal components” (see, the Krauter reference at column 1, lines 9-11; column 3, lines 12-16, and column 2, lines 1-14). Such reports do not cure the deficiency of the Larsson reference noted above.

Thus, the claimed invention is not obvious in view of the combination of the Larsson and Fisons references. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

Applicants respectfully submit that the claims are in condition for allowance. An early notice of the same is earnestly solicited. The Office is invited to contact Applicants’ undersigned representative at 610.640.7859 to resolve any remaining issues.

The Commissioner is hereby authorized to debit any underpayment of fee due or credit any overpayment to Deposit Account No. 50-0436.

Respectfully submitted,

/Paul K. Legaard, Reg.# 38534/
Paul K. Legaard, Ph.D.

Date: **3 September 2008**

Pepper Hamilton LLP
400 Berwyn Park
899 Cassatt Road
Berwyn, PA 19312-1183

Telephone: 610.640.7859
Facsimile: 267.430.7647